

Claim Rejection under 35 U.S.C. §112 Second Paragraph

Claim rejection under 35 U.S.C. §112 does not apply. Claims 9-13 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In specific regard to the rejection of claim 9, the phrase "vice-type" has been deleted. As amended, claim 9 is sufficiently clear to avoid invalidity on indefinite grounds.

Claim 9 has additionally been rejected for indefiniteness in regard to the recitation of "a receiving cavity" and "second guide portion". Amended claim 9 includes a structural relationship between the parts. The structural relationship between the two parts is present in one pertinent portion of claim 9 where "a second guide portion, at least partially defined by the receiving cavity". The rejection of claim 9 under 35 U.S.C. §112 second paragraph no longer applies.

Rejection of Claims 9-11 and 13 Under 35 U.S.C. §103(a)

Claims 9-11, and 13 were rejected under 35 U.S.C. §103(a) as being obvious over United States Patent No. 4,768,963 to Barron in view of United States Patent No. 4,103,986 to Israeli. The Office Action has failed to establish a *prima facie case*.⁵

Claim Rejections Under 35 U.S.C. §103, Prima Facie Case Not Established

To establish the legal conclusion of a *prima facie* case of obviousness, three (3) basic criterions must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations. A *prima facie* case of obviousness "means not only that the evidence of the prior art would reasonably allow conclusion the examiner seeks, but also that the prior art compels such a conclusion if the Applicant produces no evidence or argument to rebut it". In re Spada, 911 F.2d 705,708 n.3, 15 USPQ 2d 1655, n.3 (Fed. Cir. 1990). It is well recognized that

due caution should be exercised by an Office Action in constructing a conclusion of obviousness by combining references. The combination of features found in the cited references in this case should be carefully examined. The courts have stated clearly that "it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill. In re Hedges, 783 F.2d 1038, 228 USPQ 685, 687 (Fed. Cir. 1986), citing In re Wesslau, 353 F.2d at 241, 147 USPQ at 393.

All Claim Limitations Are Not Taught Or Suggested

It is well established that when even one claimed limitation is not found in the combination of prior art, a rejection under 35 U.S.C. §103 is improper. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The Barron reference is directed toward a ground connector that does not have a movable member (9) defining a receiving cavity with a second guide portion (11) at least partially defined by the receiving cavity. The Israeli reference neither has, at least, a first guide portion 92 as a component of the saddle member 52 having a spade connector 104, nor is the second guide portion 84 defined by the receiving cavity (alleged to be between 82 and 84 of the free floating pressure plate 76). In addition both the Barron and Israeli references do not have a pair of opposing ribs and said other said first guide portion and second guide portion has a pair of opposing channels which cooperate with said ribs as required in all of the pending claims.

It simply is not the case that all of the elements of the claimed invention are present either expressly or inherently in the combination suggested. The courts have clearly stated that inherent anticipation requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citing Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). The combination of Barron and Israeli as suggested in the Office Action simply does not yield, at the least, the Applicants claimed invention of a

base "comprising a fixed jaw and a first guide portion" and a movable member defining a receiving cavity with a second guide portion 11 at least partially defined by the receiving cavity. In addition, the elements of a pair of opposing ribs and said other said first guide portion and second guide portion has a pair of opposing channels which cooperate with said ribs are clearly better found nor suggested in the proposed combination or modification. Since there is no motivation or suggestion to make the modification or combination as suggested, the claimed invention is non-obvious.

Motivation Or Suggestion To Combine The References Not Found

To properly combine the references of Barron and Israeli in an effort to reach the conclusion that the subject matter of the claimed invention would have been obvious, requires some teaching, suggestion or inference in either, or both, the Barron and Israeli references, or within the knowledge generally available to one of ordinary skill in the relevant art, which would lead one skilled in the art to make the proposed combination. The Office Action asserts that motivation to combine the references is "to form the base for the base assembly, as taught by Israeli, to facilitate installation of the base to the transformer ground connecting means". The Office Action has correctly indicated that references contain neither the motivation nor suggestion to make the combination. The motivation or suggestion asserted in the Office Action is that someone having the knowledge a person of ordinary skill in the art at the time the invention was made would have found the combination obvious. The rejection is improper since the references at the least teach away from such combination or modification.

The References Teach Away From Each Other

There is no motivation or suggestion to combine or modify the references of Barron and Israeli since they teach away from each other. It is a well-established "general rule" that references that teach away cannot serve to create a *prima facie* case of obviousness. In re Gurley, 27 F3d 551, 553, 31 USPQ 2d 1131, 1132 (Fed Cir. 1994). A "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the Applicant."

Winner v. Wang, 202 F.3d 1340 (Fed Cir. 2000) citing Gurley at 553.

In considering the references, the Barron reference is directed toward a ground connector that does not have a movable member 9 defining a receiving cavity with a second guide portion 11 at least partially defined by the receiving cavity. The Barron reference in addition is lacking a pair of opposing ribs and said other said first guide portion and second guide portion has a pair of opposing channels which cooperate with said ribs. The relevant teaching is clearly toward the use of a screw member to retain a wire in place. See Barron Abstract. The Israeli reference neither has, at least, a first guide portion 92 as a component of the saddle member 52 having a spade connector 104, nor is the second guide portion 84 defined by the receiving cavity (alleged to be between 82 and 84 of the free floating pressure plate 76). Additionally, the Israeli reference does not have a pair of opposing ribs and said other said first guide portion and second guide portion has a pair of opposing channels which cooperate with said ribs. The relevant teaching from Israeli is directed toward combining numerous complex and interrelated components to retain a wire with a free floating pressure plate.

The combination of Barron and Israeli as suggested in the Office Action simply does not follow the proper teachings flowing from the disclosures of Barron and Israeli. One of ordinary skill in the art having these two references before them would find them non-productive for the purpose of creating a ground connector as the invention claimed by the Applicant. A *prima facie* case of obviousness is not established for at least this reason.

Proposed Modification Renders The Barron Invention Unsatisfactory for its Intended Purpose.

The MPEP at §2143.01 states. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" The claimed invention of claims 9-12 and 15-17 is a ground connector assembly for use in grounding a distribution transformer wherein the device is mounted by a bolt extending through said opening into ground connecting

means. The prior art Barron reference concerns a ground adapter wherein the ground adapter is "threadedly positioned in a recess or aperture in a metal object to be grounded", and wherein the ground adapter has an integral threaded portion of "typical sizes for commercial use". Column 1 lines 50-60, column 3 lines 25-63. The reference further teaches that the ground adapter comprises "a conductive body having a threaded cylindrical end portion". If the Barron prior art device were modified with a spade end which is as suggested non-cylindrical and non-threaded, it would be inoperable for its intended purpose because it could no longer be threaded to a threaded opening in the object to be grounded. A *prima facie* case of obviousness is not established for at least this reason.

Change to the Basic Principle of Operation of Barron Improper

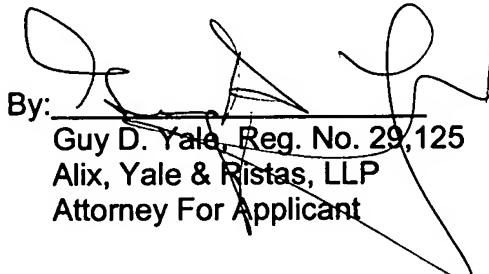
The MPEP at §2143.01 is also clear that the proposed modification cannot change the basic principle of operation under which the prior art reference operates. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) Claimed device is mounted by a bolt extending through said opening into ground connecting means. The primary Barron reference relied upon in a rejection based on a combination of references discloses a ground adapter wherein the device is to have "a conductive body having a threaded cylindrical end portion". Barron teaches that the device requires the threaded portion so that the device could be directly threaded into the object to be grounded, whereas the claimed invention of claims 9-12 and 15-17 requires a bolt extending through an opening in the device for mounting. The suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the Barron reference as well as a change in the basic principle under which the Barron construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.). A *prima facie* case of obviousness is not established for at least this reason.

In summary, Applicant has addressed each of the rejections within the present Office Action either by Amendment or Remarks. It is believed the application as amended now stands in condition for allowance, and prompt favorable action thereon is earnestly solicited.

Respectfully submitted,

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